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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,377	03/18/2005	Timothy Michael Cusack	102792-033(10997P3)	4717

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EXAMINER
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DELCOTTO, GREGORY R

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,377	<b>Applicant(s)</b> CUSACK ET AL.	
	<b>Examiner</b> Gregory R. Del Cotto	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 12/9/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 16, 25, 27, 29, 31, 32, 34, 37-39, 158-164 and 167-170 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16, 25, 27, 29, 31, 32, 34, 37-39, 158-164 and 167-170 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-3, 16, 25, 27, 29, 31, 32, 34, 37-39, 158-164, and 167-170 are pending. Claims 4-15, 17-24, 26, 28, 30, 33, 35, 36, and 40-157, and 165 have been canceled. Applicant's arguments and amendments filed 12/9/08 have been entered.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/9/08 has been entered.

#### **Objections/Rejections Withdrawn**

The following objections/rejections as set forth in the Office action mailed 1/10/08 have been withdrawn:

The rejection of claims 1, 2, 15, 16, 25, 27, 29, 31, 32, 37-39, and 158-164 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, has been withdrawn.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 16, 25, 27, 29, 31, 32, 37-39, 158-164, and 168 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO00/27271.

'271 teaches cleaning compositions, pads, wipes, and implements which provide effective cleaning of hard surfaces. See Abstract. The hard surface cleaning compositions contain from about 0.001% to about 0.5% by weight of a surfactant such as alkyl sulfonates, optionally, a hydrophilic polymer in an amount of less than about 0.5% by weight, optionally, an organic solvent, optionally, a mono or polycarboxylic acid in amounts from 0.01% to 1% by weight, optionally, a buffer, etc. See page 3, line 7 to page 4, line 10. Suitable polymers include poly(vinylpyrrolidone/acrylic acid" sold under the tradename Accumer, etc. See page 19, lines 15-30. Suitable acids include acetic acid, glycolic acid, tartaric acid, citric acid, succinic acid, etc. See page 21, lines 15-30.

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Specifically, '271 teaches compositions containing 0.01% alkyl sulfonate, 0.05% acetic acid, solvent, water, etc. See page 126, line 20 to page 127, line 10. Further, the Examiner asserts that the compositions as specifically disclosed by '271 would inherently have the antimicrobial efficacy as the compositions recited by instant claims because '271 specifically teach compositions containing the same components in the same amounts as recited by the instant claims. Additionally, note that, as disclosed on page 27 of the instant specification, a polymer/acid complex is formed by simply mixing the acid and polymer together in solution which is clearly taught by '271. '271 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '271 anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of '271 are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed antimicrobial properties of the composition in order to provide the optimum cleaning and disinfecting properties to the composition because '271 teaches that the amounts and types of required components added to the composition may be varied.

Claims 3, 34, 167, 169, and 170 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO00/27271.

'271 are relied upon as set forth above. However, '271 does not teach, with sufficient specificity, a composition containing a specific acid or specific ratio of

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components in addition to the other requisite components of the composition as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a specific acid or specific ratio of components in addition to the other requisite components of the composition as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '271 suggest composition containing a specific acid or specific ratio of components in addition to the other requisite components of the composition as recited by the instant claims.

### ***Response to Arguments***

With respect to the rejection of the instant claims under 35 USC 102 using '271, Applicant once again states that '271 recognizes water as the only essential constituent and all other constituents are considered optional such that '271 does not disclose the claimed invention with sufficient specificity to constitute anticipation. Further, Applicant states that as to the function of the polymers which are optionally included in '271, '271 makes no mention that they are to be selected on the basis of the potential ability to form a complex with at least one organic acid nor a mention of their antimicrobial efficacy. Additionally, Applicant states, as set forth previously, that '271 does not contemplate nor teach compositions which exhibit antimicrobial efficacy following washing a substrate upon which the composition has been applied. In response, note that, as stated previously, the Examiner asserts that while '271 teaches that various optional components may be used in the compositions, these optional components are

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all listed together and one of ordinary skill in the art from the teachings of '271, would immediately envisage and readily ascertain compositions containing the same components in the same amounts as recited by the instant claims. Additionally, note that, the independent instant claims simply require the use of an organic acid, polymer, and water, while the rest of the recited components are optional. Further, note that, Examples A-E on page 126 of '271 disclose mixtures of various components in which a surfactant, solvent, and water component are fixed components of the composition and one would immediately envisage the use of any of the disclosed polymers and acid with a surfactant, solvent, and water. Thus, the Examiner maintains that '271 discloses the claimed invention with sufficient specificity to constitute anticipation.

Additionally, the Examiner maintains that the polymers as taught by '271 are the same as the elected species as recited by the instant claims and would inherently have the same antimicrobial properties and ability to complex with an organic acid as recited by the instant claims. Further, the Examiner maintains that the compositions as specifically disclosed by '271 would inherently have the antimicrobial efficacy as the compositions recited by instant claims because '271 specifically teach compositions containing the same components in the same amounts as recited by the instant claims. The Examiner has provided technical reasoning to support his position of inherency and Applicant has provided no data or evidence showing the compositions as disclosed by '271 do not have the same antimicrobial properties as recited by instant claims.

With respect to the rejection of the instant claims under 35 USC 103, Applicant states once again that the Examiner has improperly relied upon hindsight reconstruction



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to arrive at the claimed invention. In response, note that, the Examiner asserts that the teachings of a reference are not limited to the preferred embodiments and that the broad teachings of '271 suggest compositions containing the same acids (cl. 3) and ratio of components (cl. 34, 167, 169, 170) as recited by the instant claims. Further, note that, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory R. Del Cotto/  
Primary Examiner, Art Unit 1796

/G. R. D./  
December 16, 2008